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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,827	03/24/2000	Domenico Orzi	252/128	2029

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EXAMINER

CHANG, AUDREY Y

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/535,827

Applicant(s)

ORZI, DOMENICO ET AL

Examiner

Audrey Y. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Reissue Applications

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a).

The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

2. The assignment from the assignors Orzi et al to assignee JAX HOLDINGS INC. is not properly recorded in the patent that is based upon for the reissue application.

Remark

3. Claims 1-2 of the original patent and newly submitted claims 3-26 in the reissue application remain pending in this application.

4. Claim 3 presented in the reissue application is a recapture of canceled claims 21, 25 and 26 in the original patent, PN. 5,731,898.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 4, 5-14, 15-24, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly submitted claim 4 recites the paragraph concerning the transmission of first waveband through the first area is 50% greater than in the second area and the transmission of the second waveband through the second area is 50% greater than in the first area that is not supported by the specification since it fails to adequately teach such feature.

Claims 5-8, 15-18, 25 and 26, recite that the transparent substrate is selected from the group consisting the claimed elements that are not supported by the specification. Although the specification teaches various applications for the optical filter however the specification fails to teach adequately how each element is actually employed as the transparent substrate.

Claims 5, 15, 25 and 26 recite that the first and second reflecting areas cooperate to define a pattern that is visibly perceptible when viewed from the front side and imperceptible when viewed from the back side of the substrate. The specification fails to teach adequately as how could by having partially reflective coatings on the first and second areas would achieve such. The essential element for making such perceptible and imperceptible characters is the metallic layers. These claims as stand now are therefore not enabling the claimed characteristics.

Claims 9 and 19 recite that the predetermined could be "devices" that is not supported by the specification, since it fails to teach how could the pattern of the filter elements be "devices".

Claims 6-14, and 16-24 inherit the rejection from their respective based claim.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 3, 5-14 and 15-24 and 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The phrases “measurably perceptible” and “substantially measurable imperceptible” recited in claim 3 are indefinite since it is not clear what does it mean by “measurably” and to what degree is the term “substantially” should be interpreted. The specification fails to provide the means to carry out the measurement for the perceptibility.

Claim 3 fails to show the connection between the **substrate** being the “transmission balancing means” and the first and second metallic thin films recited in the last paragraph of the claim. This renders the scope of the claim unclear.

The alternative phrase concerning the transparent substrate being selected from the group consisting various elements recited in claims 5, 15, 25 and 26 is indefinite since the elements in the group are not equivalent to each other, which therefore renders the scope of the claims unclear.

The alternative phrase concerning the pattern being selected from the group consisting various elements recited in claims 9 and 19 is indefinite since the elements in the group are not equivalent to each other, which therefore renders the scope of the claims unclear.

Claims 6-14 and 16-24 inherit the rejections from their respective claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2, 3, 4, 5-14, 16-24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Dillon (PN. 4,715,702) in view of the patent issued to Apfel et al (PN. 3,679,291).

Dillon teaches a decorative lens that is comprised of a *transparent substrate*, (28), a *first partially reflective coating* that is comprised of a *first optical element* (29) and the corresponding first area of a *reflective element* (27) for reflecting *red light* and a *second partially reflecting coating* that is comprised of a *second optical element* (31) and the corresponding second area of the *reflective element* (27) for reflecting *blue light*, (please see Figure 4 and column 4). The two reflective coatings define a two-colored pattern. Dillon teaches that the reflective element (27) and the colored transparent substrate (28), which therefore has absorption property, function in such way that the two-colored pattern may be visibly perceptible by an observer (35) from the front side of the substrate but visibly imperceptible when viewed by a viewer (36) from the back side of the substrate, (please see Figure 4).

This reference has met all the limitations of the claims with the exception that it does not teach explicitly that the first and second optical elements (29 and 31) for respectively reflecting red and blue light are of optical thin films or of dielectric film. Apfel et al in the same field of endeavor teaches a filter coating having asymmetric reflectance wherein thin film layers such as dielectric layers are used to provide reflection for different color of light. It would then have been obvious to one skilled in the art to apply the teachings of Apfel et al to make the color optical elements (29 and 31) of Dillon with thin film structure including dielectric films for the benefit of providing an alternative and well-known structure for the color filter elements to make the decorative lens.

With regard to claims 1-2, 3, 4, 13-14 and 23-24, Dillon also does not teach explicitly that the reflective element is metallic thin film. Apfel et al in the same field of endeavor teaches a multi-

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chromatic optical filter that has a metal layer (26) placed underneath film layers forming an optical coating that serves as an absorbing layer such that the color appearance of the filter will not be observed when viewed from the back side of the substrate, (please see Figure 1, column 10). It would then have been obvious to one having ordinary skill in the art to apply the teachings of Apfel et al to replace the reflective element (27) of Dillon by a metal layer for the benefit of providing an alternative and well-known means for achieving the same purpose as to make the color feature of the decorative lens imperceptible from the back side of the lens. With regard to the feature concerning the thickness of the metal layer or the reflective layer being of the same thickness or not, these reference does not teach explicitly that the thickness is not the same for different color regions. However since both the reflective element of Dillon and the metal layer of Apfel et al serve the purpose of making the color feature of the decorative lens not perceptible from the back side, the feature concerning the thickness therefore is not criticality for the function or for anything. It is therefore considered as obvious matter of design choice to one skilled in the art.

With regard to claims 5-8, 15-18, 25 and 26, Dillon teaches the substrate is a lens for sunglasses, (please see column 1 and 3, Figures 1, 3A-3D, and 6). Although this reference does not teach explicitly that the substrate can also be the various elements, however the specification of the instant application does not teach such either. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Madham*, 2 USPQ2d 1647 (1987).

With regard to claims 9-12, and 19-22, Dillon teaches that the decorative pattern of the color fields may be in the form of a logo, (please see Figures 1, 3D and 4).

Reissue Applications

11. Claims 1-26 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 3 presented in the instant application is a recapture of canceled claims 21, 25 and 26 of the original patent, PN. 5,731,898.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Audrey Y. Chang whose telephone number is 703-305-6208. The examiner can normally be reached on Monday-Friday (8:00-4:30), alternative Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703-308-1637. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

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Audrey Y. Chang
Primary Examiner
Art Unit 2872

A. Chang, Ph.D.
December 27, 2001

A handwritten signature in black ink, appearing to be 'Audrey Y. Chang', written in a cursive style.